

II. Claims 37-51, directed to a fiber optic switch. one of the following species under 35 U.S.C. § 121:

The Applicant hereby provisionally elects, Group I claims 1-36, with traverse.

In making the requirement, the Examiner states that Group I and Group II are related as 5 combination and subcombination. The Examiner argues that, under MPEP 806.06(c), the restriction is proper since the combination, as claimed, does not require the particulars of the subcombination for patentability because the mirrors can use alternate switching means. The Examiner also argues that the subcombination has a separate utility.

10 The Applicant traverses the requirement on the grounds that it is improper under MPEP 806.05(c) since the subcombinations of Group I are essential to the combination in all claims in Group II. In particular each independent claim in Group I (claims 1 and 23) has a counterpart in Group II containing all the limitations of the corresponding Group I claim. Specifically claim 37 clearly recites that each scanner in the claimed optical switch includes all the features recited in claim 1. Similarly claim 45 recites that each 15 scanner in the claimed optical switch includes all the features of claim 23. MPEP 806.05(c)(II) clearly states:

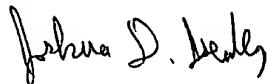
20 “Where the relationship between the claims is such that the separately claimed subcombination  $B_{sp}$  constitutes the essential distinguishing feature of the combination  $AB_{sp}$  as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.” [Emphasis added]

In the present application claims 1 and 23 define specific subcombinations ( $B_{sp}$ ) that are combined with other elements (A) in the corresponding optical switch claims 37 and 45. Thus the restriction between Group I and Group II is of the type  $AB_{sp}/B_{sp}$ . This is 25 precisely the situation contemplated by MPEP 806.05(c) where restriction *would not be proper*. Furthermore, MPEP 806.05(c) clearly states the separate utility of the subcombination is irrelevant in this situation. As such the Applicants respectfully request that the Examiner withdraw the requirement

CONCLUSION

In view of the above remarks, the applicants respectfully request that the Examiner withdraw the restriction requirement, consider the application and point out the allowable subject matter in the next Office Action.

5 Respectfully submitted,



Joshua D. Isenberg  
Patent Agent  
10 Reg. No. 41,088

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*JDI PATENT*  
204 Castro Lane  
Fremont, CA 94539  
tel.: 510-896-8328